



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,944	03/31/2004	Frank Westendorf	07781.0080	4926

22852 7590 06/29/2007
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

LEWIS, CHERYL RENE A

ART UNIT	PAPER NUMBER
----------	--------------

2167

MAIL DATE	DELIVERY MODE
-----------	---------------

06/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/812,944

Applicant(s)

WESTENDORF ET AL.

Examiner

Cheryl Lewis

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

1. This office action is in response the applicants' amendment received on December 15, 2006.
2. Claims 1-35 are presented for examination.
3. The applicants have amended claims 1 and 16. The applicants have not cancelled or added any claims.
4. Applicants' arguments with respect to claims 1-35 have been fully considered but they are not deemed to be persuasive.

Request for Reconsideration

5. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Remarks

6. The examiner acknowledges and thanks the applicants for the amendment to claims 1 and 16. However, the newly added claim limitations to claims 1 and 16 including "to assign an action to said determined data objects and to said initial data object" does not overcome the 35 USC 101 rejection. The examiner has maintained the 35 USC 101 rejection for the reasons stated in the office action below.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1 and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As follows:

Claims 1 and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject. Claims 1 and 16 are directed to identifying an initial data object that is to be processed as a selected object, a process chain contains the selected data object that is to be processed. A determination is made to determine the data objects that are linked with the selected data object as a causal relation and processing the determined objects and the initial object to assign an action to the determined data objects and to the initial data object.

The claimed inventions, as a whole must accomplish a **practical application**. That is, it must produce a **“useful, concrete and tangible result.”** *State Street, 149 F.3d at 1373, 47 USPQ2s at 1601-02. MPEP 2106*. In each of these cases the **result** identifying, selecting, and processing the selected data object. The claimed limitations are an abstraction as they are not **useful, concrete, and tangible** they are not put in any tangible form and not useful because they are not presented in such a way as to produce and/or provide some result that is of utility that may exist in the specification however no specific use is provided for in the claimed invention. Thus the claims are non-statutory and stand rejected under 101 as not **producing a “useful, concrete and tangible result.”**

At best the claim limitations are identifying an initial data object that becomes a selected object. The selected object is processed in a chain of data objects. A determination is made that links the selected object as a causal relation. A process is performed on the determined objects and initial object to "assign an action" to the determined objects and the initial object.

The claim limitations do not produce a useful, concrete, and tangible result. The data objects are assigned an "action". This assigned "action" must perform and produce a result. The claim limitations do not recite in detail what this "assigned action" is nor do the claims recite in detail what would be the end result of performing a particular "action" to the data objects.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1 and 16 recite claim limitations as follows:

(1) chains of linked data objects, (2) initial data object, (3) chain containing said selected data object, (4) selected data object in a causal relation, (4) determined data objects, and (5) an action

Art Unit: 2167

The claim limitations do not include a detailed description about the type (attributes) of data objects (initial, selected, determined, etc.) that are presented in the claims nor do the claims include a detailed description (attributes) including the functionality of chains containing links, chains of data objects, causal relation, and an action.

Simply put, what is an "action", "chains of linked data objects", "causal relation", etc.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Schuler et al. (Patent No. 5,855,005 filed June 24, 1996, hereinafter Schuler).

13. Regarding Claims 1, 16, and 17, Schuler teaches a system for electronically auditing exposures used for determining insurance premiums.

The method and associated system for electronically auditing exposures used for determining insurance premiums as taught or suggested by Schuler includes: identifying at least one initial data object to be processed has been selected (col. 6, lines 1-4, element 730, 'Appointment Letters'), at least one process chain containing a selected data object to be processed (col. 6, lines 25-34, 'The Menu 800 includes boxes

810, 820, 830, and 840 which correspond to different pre-prepared form letters to be used by an auditor in scheduling audit appointments.');

...determining all of the data objects (col. 6, lines 1-24, figures 1 and 7, '...by clicking on box 730, the auditor may direct system 100 to proceed to step 122 wherein one or more appointment letters may be issued to insureds being audited'; '...elements 122, 124, 126, 132, 136, or 138, system 100 proceeds back to step 120 where the Policy View/Audit View Menu 700 is displayed for the auditor.')

...which are linked with a selected data object (col. 6, lines 1-24, 'Appointment Letter', i.e., '...by clicking on box 730') in a causal relation (col. 6, lines 1-24, '...one or more appointment letters may be issued to insureds being audited');

...and processing determined data objects (col. 6, lines 25-34, 'The Menu 800 includes boxes 810, 820, 830, and 840 which correspond to different pre-prepared form letters to be used by an auditor in scheduling audit appointments.', col. 6, lines 34-44, 'Upon clicking one of the boxes 810, 820, 830, or 840, a form of an appointment letter (such as, for example, letter 900 shown in FIG. 9) is automatically generated by system 100. In generated this form letter, system 100 pre-fills the insured's name and address, policy type, policy number and policy period into the letter based on information previously entered and stored in database 400. In order to complete the appointment letter 900, an auditor then enters a contact name 910, an audit date 920 and designates the records 930 that will be required for the audit.')

...and initial data object (col. 6, lines 1-24, 'Appointment Letter', i.e., '...by clicking on box 730') to assign an action (col. 6, lines 1-47, i.e., 'an Appointment Letter Menu') to determined data objects and to initial data object.

14. Regarding Claims 2 and 18-20, Sumino teaches resetting determined data objects (col. 4, lines 63-67, col. 5, lines 1-8, col. 6, lines 1-47); executing a desired processing of the initial data object (col. 6, lines 1-47); and recalculating consecutively determined data objects reset in the resetting step being in causal relation with initial data object (col. 10, lines 1-13, '...verification and reconciliation sheet 1900.').

15. Regarding Claim 3, Sumino teaches resetting and recalculating (col. 10, lines 1-13) the step of cancelling a determined data object (col. 4, lines 63-67, 'An auditor at the Audit Inventory Menu may also add/delete an insurance policy...', col. 5, lines 1-22, 'Cancel Date: The cancellation date, if applicable, of the policy.', col. 6, lines 1-47).

16. Regarding Claims 4-6 and 21-24, Sumino teaches data objects contain a time index and data objects starts with the data object containing the most recent time index and steps back consecutively to a selected data object (col. 6, lines 36 and 48-61, '... in box 710 of Menu 700 such as, for example, the effective and expiration dates of the policy...').

17. Regarding Claims 7-10, Sumino teaches all data objects are locked from access upon selection of a data object until termination of the step of processing (col. 6, lines 36 and 48-61).

18. Regarding Claims 12-15 and 30-35, Sumino teaches grouping and sorting data objects (col. 6, lines 1-34).

19. Regarding Claims 25-29, the limitations of these claims have been noted in the rejections of claims 2, 7-10, and 18-20 presented above. It is therefore rejected as set forth above.

NAME OF CONTACT

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (571) 272-4113. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

(571) 273-4113 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/ Technology Center (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 2167

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cheryl Lewis/

Patent Examiner, A.U. 2167

June 22, 2007